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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/674,589

09/29/2003

Chen Chin J. Huang

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11/21/2006

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EXAMINER

GELLNER, JEFFREY L

ART UNIT

PAPER NUMBER

3643

DATE MAILED: 11/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/674,589

Applicant(s)

HUANG, CHEN CHIN J.

Examiner

Jeffrey L. Gellner

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 4-24 and 26-28 is/are pending in the application.
- 4a) Of the above claim(s) 13-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4-12, 21-24, 26-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Declaration of Chen Chin J. Huang

The Declaration of Chen Chin J. Huang under 37 CFR 1.132 (assumed to be filed under 37 CFR 1.132) filed 8 September 2006 is insufficient to overcome the rejection of all non-cancelled claims based upon Otake(s), Bales, and DiMuzio as set forth in the last Office action because:

It refer(s) only to the system described in the above referenced application and not to the individual claims of the application. Thus, there is no showing that the objective evidence of nonobviousness is commensurate in scope with the claims. See MPEP § 716.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 4-11, 21, 24 25, 27, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Otake (JP2000-201545) in view of Bales (US 4,258,503) in further view of DiMuzio (US 6,237,882 B1).

As to Claim 1, 24, 27, and 28, Otake discloses a maneuverable topiary frame (Figs. 1-11) comprising two or more separable members (16 and 2 of Fig. 3); one or more hinges (13 of Fig. 1), integrally a part of the frame, and connecting at least two adjoining separable members (Figs.

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1 and 3); one or more clips permanently affixed to a member (region around 14 of Fig. 1); and, an aperture at a bottom of the frame (inherent from Figs. 1 and 3); wherein at least one of the hinges adjoining two of the members forms a main structure (shown in Fig. 1) having an interior side and an exterior side (interior and exterior of structure in Fig. 1), and wherein the one clip when released enable one or more of the two separable members to move upon a center axis (horizontal axis through the structure) and pivot or rotate along their hinges such that the interior side of the main structure is completely exposed (in that the structure is visible or open to view) allowing the main structure to be open to positioning around a growing plant (structure capable of positioning around a growing plant) and ease in manipulation of the plant throughout all separable members, and when engaged secure the two separable members from moving, as a three-dimensional unitary form (Fig. 1); and, support pieces (shown in Fig. 1 as some of the cross supports) to support the entire frame. Not disclosed is the aperture formed from bottom edges of the two separable members when in the closed position, the aperture parted open along the center axis upon the hinges, and the aperture allowing for the main structure to enclose around a plant without lifting the plant's base; and, a smooth edged woven mesh filler woven over an about the support pieces filling spaces between the support pieces. Bales, however, discloses a topiary with a main structure having two separable members which are symmetrical that could be connected by the hinge of Otake; and, DiMuzio discloses a smooth edged woven mesh filler woven over an about the support pieces filling spaces between the support pieces (shown in Fig. 14). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the frame of Otake by having the separable members along a central axis as disclosed by Bales which would result in an aperture formed from bottom edges of the two

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separable members when in the closed position, the aperture parted open along the center axis upon the hinges, and the aperture allowing for the main structure to enclose around a plant without lifting the plant's base; and, by using a filler mesh as disclosed by DiMuzio so as to provide additional support and shape (see DiMuzio at col. 4 lines 44-48).. The frame of Otake as modified by Bales and DiMuzio inherently perform the method steps recited in claims 27 and 28.

As to Claim 4, Otake as modified by Bales and DiMuzio further disclose one or more hinges that are two lengths of interwoven wire (the top and bottom hinges shown above 13s in Fig. 1; that is hinges at very top and bottom of 12 in Fig. 1) in along a common axis of the two separate members.

As to Claim 5, Otake as modified by Bales and DiMuzio further disclose hooks (14 of Fig. 1) for clips.

As to Claims 7 and 9, Otake as modified by Bales and DiMuzio further disclose the three-D unitary form being a bear with upper and lower extremity set of members, arms and legs (Figs. 1-11), for enclosing topiary foliage (capable of enclosing topiary foliage); the main structure corresponding to a torso of an animal (Fig. 1), the arms and legs connected to the torso (Fig. 1).

As to Claim 11, Otake as modified by Bales and DiMuzio further disclose the one or more clips located opposite the hinges (Fig. 1 of Otake).

As to Claim 21, Otake as modified by Bales and DiMuzio further disclose the center axis located at a half way point of the main structure (in that there is a horizontal axis half way "up" the structure of Fig. 1).

As to Claim 6, the limitations of Claim 3 are disclosed as described above. Not disclosed are the support pieces higher gauge wire and the filler being lower gauge wire. DiMuzio, however, discloses a frame with support pieces higher gauge wire (col. 3 lines 56-58) and the filler being lower gauge wire (col. 4 lines 44-46).

As to Claim 8, Otake in view of Bales and DiMuzio further disclose the extremities correspond to objects in addition to arms and legs (in that, 20 of Fig. 14 is capable of holding fruit, vegetables, or candles - col. 4 lines 11-21 of DiMuzio).

As to Claim 10, the limitations of Claim 8 are disclosed as described above. Not disclosed is the animal from being a seal with the object a ball. However, because a bear design with fruit etc. was an art-recognized equivalent to a seal and ball in animal-from topiaries where in is immaterial as the exact animal form, it would have been obvious to one of ordinary skill in the art at the time of the invention to substitute the bear/fruit with the seal/ball in the topiary of Otake as modified by Bales and DiMuzio.

Claim 12 is rejected under 35 U.S.C. §103(a) as being unpatentable over Otake (JP2000-201545) in view of Bales (US 4,258,503) and DiMuzio (US 6,237,882 B1) in further view of Pierce (US 4,190,984).

As to Claim 12, the limitations of Claim 1 are disclosed as described above. Not disclosed is the wire galvanized. Pierce, however, discloses a topiary with galvanized wire (col. 4 lines 24-28). It would have been obvious to one of ordinary skill in the art at the time of the invention to further modify the frame of Otake as modified by Bales and DiMuzio by using

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galvanized wire as disclosed by Pierce so as to have the wire resistant to the weather so as to prolong the outdoor life of the frame.

Claims 22 and 23 are rejected under 35 U.S.C. §103(a) as being unpatentable over Otake (JP2000-201545) in view of Bales (US 4,258,503) and DiMuzio (US 6,237,882 B1) in further view of Pan (US 5,850,927).

As to claim 22, the limitations of Claim 1 are disclosed as described above. Not disclosed are the upper and lower extremities separable from the main structure and each of the set of members pivots about a hinge connecting each set of members to the main structure, each of the set of members further comprising a clip opposite to its hinge for releasing and securing each of the set of members to the main structure. Pan however discloses a topiary-like structure with sets of members hinged and separable from the main structure (Figs. 2 and 3; Figs. 4 and 5), each with hinges and clips (Figs. 2-5), and it is obvious to place the clips in positions to optimize the releasing and securing procedure. It would have been obvious to one of ordinary skill in the art at the time of the invention to further modify the frame of Otake as modified by Bales and DiMuzio by adding hinged extremities as disclosed by Pan so as to allow the structure to be folded for storage (see Pan at col. 2 lines 23-27).

As to claim 23, Otake as modified by Bales, DiMuzio, and Pan further disclose the upper and lower extremities being arms, legs, and additional objects (legs and head portions of Pan) and the main structure the middle region of the animal form (see both Pan and Otake).

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Claim 26 is rejected under 35 U.S.C. §103(a) as being unpatentable over Otake (JP2000-201545) in view of Bales (US 4,258,503) and DiMuzio (US 6,237,882 B1) in further view of Otake (JP2001-62156).

As to claim 26, the limitations of claim 1 are disclosed as described above. Not disclosed is are the upper and lower extremities being separable from the main structure and the extremities pivoting about a hinge connecting the extremities to the main structure, and further comprising a clip opposite the hinge for releasing and securing the extremity to the main structure. Otake, however, discloses upper and lower extremities being separable from the main structure (from Figs. 1b, 3b, and 4b) and the extremities pivoting about a hinge (head portion of 11 and 2 of Fig. 3b) connecting the extremities to the main structure, and further comprising a clip opposite the hinge (8 of Fig. 3b) for releasing and securing the extremity to the main structure. It would have been obvious to one of ordinary skill in the art at the time of the invention to further modify the frame of Otake as modified by Bales by adding hinged extremities as disclosed by Otake so as to allow the structure to be folded changed into a preferable pose (see Otake at "PROBLEM TO BE SOLVED" portion of abstract in English).

Response to Arguments

Applicant's arguments filed 8 September 2006 have been fully considered but they are not persuasive. Applicant's arguments are: (1) neither Otake ('545), Bales, DiMuzio, nor Otake ('156) disclose the support frame and a smooth edged woven mesh filler woven over and about the support pieces (Remarks bottom of page 10, top of page 11, bottom of page 14); (2) the instant invention has unexpected result and shows commercial success (Remarks bottom of page

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11, top of page 12); (3) the upper and lower extremity set of members, or objects, are for enclosing topiary foliage and DiMuzio's do not (Remarks top of page 13); and, (4) references used in rejections do not disclose a seal with a fruit (Remark bottom of page 13).

As to argument (1), Examiner considers DiMuzio to disclose a smooth edged woven mesh filler because of Fig. 14. There appears to be no rough edges, *i.e.*, it appears to be smooth. Additionally, it has weave shape and is "over" the support structures so it is a "woven mesh filler woven over and about the support structure" (see claim 1 (currently amended)). Examiner does not consider the amended language of "woven" to be a method step because of lack of the use of the word - weaving.

As to argument (2), the unexpected results of the instant invention are not supported by evidence in the record. See MPEP 716.01(c)(II) for the proposition that arguments of the attorney is not a substitute for objective evidence. Similarly, for the declaration of commercial success, even if the declaration recited specific claims and language, there is no showing of data to evidence commercial success. Sales figures for the instant invention are given in paragraph 3 for several years, but, for example, these figures are not compared to other topiaries nor is the amount of advertising given for the instant invention and other topiaries.

As to argument (3), the objects of DuMuzio would cover some foliage in that virtually any object on the support structure would cover some foliage.

As to argument (4), Examiner considers the shape of the topiary, absent some inventive step in its construction, to be a design choice predicated on consumer demand or aesthetic appeal. Here, the shape of the topiary is considered to be a design choice.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

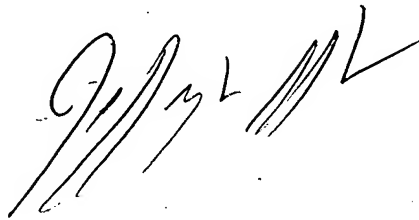
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey L. Gellner whose telephone number is 571.272.6887. The examiner can normally be reached on Monday-Friday, 8:30-4:00, alternate.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Poon can be reached on 571.272.6891. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read 'J. Gellner', with a stylized flourish at the end.

Jeffrey L. Gellner
Primary Examiner
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